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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,123	02/21/2002	Richard E. Riley	A-70431/ESW	8541
7590	12/03/2003			
FLEHR HOHBACH TEST ALBRITTON & HERBERT LLP Suite 3400 Four Embarcadero Center San Francisco, CA 94111-4187			EXAMINER	CHEVALIER, ALICIA ANN
			ART UNIT	PAPER NUMBER
			1772	
			DATE MAILED: 12/03/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

CLO 14

Office Action Summary	Application No.	Applicant(s)	
	10/081,123	RILEY, RICHARD E.	
	Examiner	Art Unit	
	Alicia Chevalier	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 September 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
 - 4a) Of the above claim(s) 13-16 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-12 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|--|
| <ol style="list-style-type: none"> 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | <ol style="list-style-type: none"> 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____ 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____ |
|---|--|

RESPONSE TO AMENDMENT

WITHDRAWN REJECTIONS

1. The objections to the specification of record in paper #5, pages 3-6 have been withdrawn due to Applicant's amendment in paper #13.
2. The 35 U.S.C. §112 rejections of record in paper #5, page 6, paragraph #7 have been withdrawn due to Applicant's amendment in paper #13.
3. The 35 U.S.C. §102 rejection of claims 1, 2, 4-6 *only* as anticipated by Dery et al. (4,640,981) of record in paper #5, pages 6-7, paragraph #9 have been withdrawn due to Applicant's amendment in paper #13.
4. The 35 U.S.C. §102 rejection of claims 7-10 as anticipated by Bosze et al. (4,732,802) of record in paper #5, page 7, paragraph #10 have been withdrawn due to Applicant's amendment in paper #13.
5. The 35 U.S.C. §103 rejection of claim 3 *only* over Dery et al. (4,640,981) in view of Bosze et al. (4,732,802) of record in paper #5, page 8, paragraph #12 have been withdrawn due to Applicant's amendment in paper #13.

REJECTIONS REPEATED

6. The 35 U.S.C. §102 rejection of claims 7, 8 and 10-12 *only* as anticipated by Dery et al. (4,640,981) is repeated for reasons previously of record in paper #5, pages 6-7, paragraph #9.

7. The 35 U.S.C. §103 rejection of claim 9 *only* over Dery et al. (4,640,981) in view of Bosze et al. (4,732,802) is repeated for reasons previously of record in paper #5, page 8, paragraph #12.

NEW REJECTIONS

8. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Claim Rejections - 35 USC § 102

9. Claims 1, 2, 4 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Chacko (6,228,288).

Chacko discloses a conductive plastic resistance element having particles of conductive material with an average particle size in the range of about 0.1-10 microns embedded therein and projecting therefrom (col. 2, lines 66 bridging col. 3, line 8 and col. 3, lines 40-52). The conductive material consists of silver and is present in an amount equal to about 40-85 wt.% (col. 3, lines 3-8).

The limitation(s) “for a variable resistor” and “for sliding contact with the wiper contact of the variable resistor” in claim 1 are (an) intended use limitation(s) and are not further limiting in so far as the structure of the product is concerned. “[I]n apparatus, article, and composition claims, intended use must result in a *structural difference* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. *If the prior*

art structure is capable of performing the intended use, then it meets the claim." See MPEP § 2111.02.

10. Claims 1, 2 and 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Chan et al. (5,855,820).

Chan discloses a conductive plastic resistance element having particles of conductive material with a particle size in the range of about 1-30 microns embedded therein and projecting therefrom (col. 1, lines 44 bridging col. 2, line 21). The conductive material consists of silver and is present in an amount equal to about 20-80 wt.% (col. 1, lines 44-61).

The limitation(s) "for a variable resistor" and "for sliding contact with the wiper contact of the variable resistor" in claim 1 are (an) intended use limitation(s) and are not further limiting in so far as the structure of the product is concerned. "[I]n apparatus, article, and composition claims, intended use must result in a *structural difference* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. *If the prior art structure is capable of performing the intended use, then it meets the claim.*" See MPEP § 2111.02.

Claim Rejections - 35 USC § 103

11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chacko (6,228,288) in view of Bosze et al. (4,732,802).

Chacko discloses all the limitations of the instant claimed invention except that the conductive material consists of silver and palladium.

Bosze discloses a resistance element comprising a matrix with conductive phases for reducing variations in resistance between the wiper a contact and the resistance element over the life of the device (col. 1, lines 6-25 and col. 4, lines 11-35). The conductive phases may consist of silver, silver and palladium, gold etc. (col. 2, lines 36-46). The noble metals for the conductive phases are preferred in high temperature environments where nickel/chrome may be prone to oxidation (col. 2, lines 36-46).

Bosze shows that silver and silver and palladium are equivalent conductive phase material in the art. Therefore, because these materials silver and silver and palladium were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute silver for silver and palladium. One of ordinary skill in the art would be motivated to use silver and palladium as the conductive phase material because of it is not prone to oxidation in high temperature

as taught by Bosze *in Charko*

ANSWERS TO APPLICANT'S ARGUMENTS

12. Applicant's conformance to specification guidelines set forth in chapter 600 of the MPEP is appertained.
13. Applicant's arguments filed in paper #13 regarding the 35 U.S.C. §112 rejections of record have been considered but are moot since the rejections have been withdrawn.
14. Applicant's arguments filed in paper #13 regarding the 35 U.S.C. §102 rejection of claims 1, 2, 4-6 *only* as anticipated by Dery et al. (4,640,981) of record have been considered but are moot since the rejections have been withdrawn.

15. Applicant's arguments filed in paper #13 regarding the 35 U.S.C. §102 rejection of claims 7, 8 and 10-12 *only* as anticipated by Dery et al. (4,640,981) of record have been carefully considered but are deemed unpersuasive.

Applicant argues that claim 7 distinguishes over Dery et al. in that it is directed to a resistance element “*for use in a potentiometric device having a wiper contact which engages the resistance element*” and that the element comprises “a carbon/plastic matrix with conductive phases *for reducing variations in resistance between the wiper contact and the resistance element over the life of the device.*” As stated in the previous office action, the phrases “for use in a potentiometric device having a wiper contact which engages the resistance element” and “for reducing variations in resistance between the wiper contact and the resistance element over the life of the device” are held to be an intended use phrase. It has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitations. The limitations are not further limiting in so far as the structure of the product is concerned. “[I]n apparatus, article, and composition claims, intended use must result in a *structural difference* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. *If the prior art structure is capable of performing the intended use, then it meets the claim.* In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.” [emphasis added] *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). See MPEP § 2111.02. These limitations do not structurally effect the claim because they are merely intended uses of the resistance element and do not

positively recite structural limitations of the potentiometric device, wiper contact, etc. Therefore Dery anticipates claim 7 because it meets all the positively recites structural limitations.

16. Applicant's arguments filed in paper #13 regarding the 35 U.S.C. §102 rejection of claims 7-10 as anticipated by Bosze et al. (4,732,802) of record have been considered but are moot since the rejections have been withdrawn.

17. Applicant's arguments filed in paper #13 regarding the 35 U.S.C. §103 rejection over Dery et al. (4,640,981) in view of Bosze et al. (4,732,802) of record have been carefully considered but are deemed unpersuasive.

Applicant argues that since claim 9 depends from claim 7 it distinguishes over Dery for the same reasons as their parent claim. Applicant's argues regarding claim 7 have already been addressed above.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9306. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac

11/19/03


HAROLD PYON
SUPERVISORY PATENT EXAMINER
11/19/03